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DL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097050,991	03/31/98	GETZENBERG	R 76333/150

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HM12/0913

EXAMINER
EPPS, J

ART UNIT	PAPER NUMBER
1635	5

DATE MAILED: 09/13/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/050,991

Applicant(s)
Getzenberg

Examiner
Janet Epps

Group Art Unit
1635



☒ Responsive to communication(s) filed on Mar 31, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-47 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-47 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, 16, 17, 21, and 40-43, drawn to proteins, classified in class 530, subclass 350.
 - II. Claims 4-14, 16-20, 22-23, 27-31, 34-39 and 44-47, drawn to polynucleotides, classified in class 536, subclass 23.1.
 - III. Claim 15-17, 22, 24-29, 32-34 drawn to an antibody, classified in class 424, subclass 130.1.
2. The inventions are distinct, each from the other because of the following reasons:

The purified polynucleotide of invention II is related to the polypeptide of invention I by virtue of encoding the same. The DNA molecule has utility for recombinant production of the protein in a host cell, however the DNA molecule and the protein it encodes are distinct inventions since they are physically and functionally distinct chemical entities, and the protein product can be made by another materially different process, such as by synthetic peptide synthesis or purification from natural sources. The DNA may be used for processes other than the production of the protein, such as nucleic acid hybridization assay. Furthermore, the nucleic acid and methods of group II are distinct from the products of Invention III wherein the two groups of products are physically and functionally distinct chemical entities, and the methods of Invention II can neither utilize the products of Invention III nor can be used to make such products.

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The polypeptide of Invention I is related to the antibody of Invention III by virtue of being the cognate antigen, necessary for the production of the antibodies. Although the protein and antibody are related for this fact, they are distinct inventions because they are physically and functionally distinct chemical entities, and because the protein can be used in another materially different process from the use for production of the antibody, such as in a pharmaceutical composition in its own right, and in a variety of other methods including detection of other molecules that bind to the protein other than antibodies.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. A telephone call was made to Stephen B. Maebius on 9/10/99 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

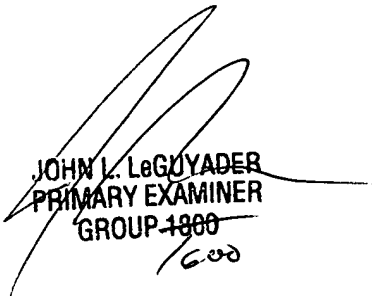
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps whose telephone number is (703) 308-8883. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, can be reached at (703) 308-4003. The fax number for this group is (703) 305-7939.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Janet L. Epps, Ph.D.


JOHN L. LEGUYADER
PRIMARY EXAMINER
GROUP 1800
600

September 10, 1999